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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/601,741

Filing Date: June 23, 2003

Appellant(s): STARBUCK ET AL.

David Matthew Noonan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/05/08 appealing from the Office action mailed 1/10/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2003/0041126	Buford et al	2-2003
2003/0149733	Capiel	3-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-12 and 73 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035

.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-8, 10-12, 42-49, 51-52 and 73 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. 2003/0041126 to Buford et al.

a. As per claims 1 and 73, Buford et al teaches a spam detection system comprising: a message parsing component that identifies features relating to at least a portion of origination information of a message (See page 3, paragraph [0036], *using an analysis protocol on the spam email to analyze the format and extract specific information of the message*); and a feature pairing component that combines the features into useful pairs, the features of the pairs are evaluated for consistency with respect to one another to determine if the message is spam (See page 4, paragraph [0047-0049] and figure 7).

b. As per claim 42, Buford et al teaches a method that facilitates generating features for use in spam detection comprising: receiving at least one message; parsing at least a portion of a message to generate one or more features (See page 3, paragraph [0036]); combining at least two features into pairs, each pair of features creates at least one additional feature, the features of each pair coinciding with one another (See page 4, paragraph [0047-0049]); using the pairs of features to train a machine learning spam filter regarding acceptable or unacceptable pairs; and

detecting a spam e-mail based at least in part on comparing one or more pairs of features in the e-mail to at least one pair in the machine learning spam filter (See pages 4-5, paragraph [0049]).

- c. As per claims 2 and 44, Buford et al teaches the claimed invention as described above. Furthermore, Buford et al teaches each pair comprises at least one of the following: at least one of a domain name and a host name in a MAIL FROM command; at least one of a domain name and a host name in a HELO COMMAND; at least one of an IP address and a subnet in a Received from header; at least one of a domain name and a host name in a Display name; at least one of a domain name and a host name in a Message From line; and at least one time zone in a last Received from header (See page 4, paragraph [0047-0049]).
- d. As per claims 3 and 45, Buford et al teaches the claimed invention as described above. Furthermore, Buford et al teaches the domain name is derived from the host name (See page 3, paragraph 0036]).
- e. As per claim 4, Buford et al teaches the claimed invention as described above. Furthermore, Buford et al teaches the subnet comprises one or more IP addresses that share a first number of bits in common (See page 4, paragraph [0043]).
- f. As per claims 5 and 47, Buford et al teaches the claimed invention as described above. Furthermore, Buford et al teaches a useful pair is any one of a domain name and a host name

from a Message From and from a HELO command (See page 4, paragraph [0047-0049])

g. As per claims 6 and 46, Buford et al teaches the claimed invention as described above.

Furthermore, Buford et al teaches a useful pair is a Display name domain name and host name and a Message From domain name and host name (See page 4, paragraph [0047-0049]).

h. As per claims 7 and 48, Buford et al teaches the claimed invention as described above.

Furthermore, Buford et al teaches a useful pair is any one of a domain name and a host name in a Message From and any one of a Received from IP address and subnet (See page 4, paragraph [0047-0049]).

i. As per claims 8 and 49, Buford et al teaches the claimed invention as described above.

Furthermore, Buford et al teaches a useful pair is a sender's alleged time zone and a Message From domain name (See page 3, paragraph [0036]).

j. As per claim 10, Buford et al teaches the claimed invention as described above.

Furthermore, Buford et al teaches origination information comprises SMTP commands, the SMTP commands comprise a HELO command, a MAIL FROM command, and a DATA command (See page 4, paragraph [0047-0049]).

k. As per claim 11, Buford et al teaches the claimed invention as described above.

Furthermore, Buford et al teaches the DATA command comprises a Message From line, sender's

alleged time zone, and sender's mailing software (See page 3, paragraph [0036] and page 4, paragraph [0047-0049]).

l. As per claim 12, Buford et al teaches the claimed invention as described above. Furthermore, Buford et al teaches comprising a component that applies one or more heuristics consistently to mail messages to obtain consistent feature pairing (See page 4, paragraph [0047-0049]).

m. As per claim 43, Buford et al teaches the claimed invention as described above. Furthermore, Buford et al teaches the at least a portion of the message being parsed corresponds to origination information of the message (See page 3, paragraph [0036]).

n. As per claim 51, Buford et al teaches the claimed invention as described above. Furthermore, Buford et al teaches selecting one or more most useful pairs of features to train the machine learning filter (See pages 4-5, paragraph -0049]).

o. As per claim 52, Buford et al teaches the claimed invention as described above. Furthermore, Buford et al teaches the detecting a spam e-mail based at least in part on one of: receiving new messages; generating pairs of features based on origination information in the messages (See page 3, paragraph [0036]); passing the pairs of features through the machine learning filter; and obtaining a verdict as to whether at least one pair of features indicates that the message is more likely to be spam (See pages 4-5, paragraph [0049]).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 9 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent Application No. 2003/0041126 to Buford et al in view of U.S. Patent Application No. 2003/0149733 to Capiel.

a. As per claims 9 and 50, Buford et al teaches the claimed invention as described above. Furthermore, Buford et al teaches a useful pair comprises of any one of a domain name, host name and user name derived from one of an SMTP command and a message header (See page 3, paragraph [0036]). However, Buford et al fails to teach a useful pair comprises a sender's type of mailing software

Capiel teaches wherein the server sensor program may save information about the e-mail client, such as the e-mail client software type (See paragraph [0006]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Capiel in the claimed invention of Buford et al in order to detect and monitor file formats (See paragraph [0002]).

(10) Response to Argument

Rejection of claims 1-12, 42-52 and 73 under 35 U.S.C. 101

Rejection of claims 42-52 under 35 U.S.C. 101 has been reversed.

Claims 1-12 and 73 stand rejected under 35 U.S.C. 101.

As per claims 1-12, the claimed invention is directed to a non-statutory matter as suggested by a review of the specification (See page 6, lines 23-30). Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized.

As per claim 73, the specification was reviewed to determine the broadest reasonable interpretation of the means for receiving, means for parsing means for combining and means for using. Evidence clearly suggests to one with ordinary skill that all may be reasonably implemented as software routine. Therefore, the claim was rejected as a system claim of software per se, failing to fall within a statutory category of invention (See page 6, lines 23-30).

Rejection of Claims 1-8, 10-12, 42-49, 51-52 and 73 under 35 U.S.C. 102(e)

Appellant argues that Buford et al fails to disclose or suggest “a message parsing component that identifies features relating to at least a portion of origination information of a message”. However, Buford et al teaches “parsing or separating of the nested electronic mail document into a plurality of message components such as a header and a body of the e-mail (See paragraph [0036]. It is well known to one with ordinary skill in the art that the header of the e-mail message comprises the “origination information of a message” such has the domain name, source IP address, from information. In Buford, the e-mail message is parsed to obtain URL and email address of a spam source.

Appellant argues that Buford et al fails to teach “a feature pairing component that combines the features into useful pairs, the features of the pairs are evaluated for consistency with respect to one another to determine if the message is spam”. The Examiner agrees with Appellant assertion that Buford et al already knows the message is spam upon receiving the message for parsing. However, Appellant is respectfully reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Buford et al teaches using an analysis protocol on the spam email to analyze the message components by way of the common presentation format and extract specific information of the message, such as IP address, a domain name and an electronic mail address using extractor. (See paragraph [0036]). The evaluating feature of Budford takes place 1) when the when the last

validated header is obtained to identify the actual source of the embedded email from multiple received lines of the validated header (See paragraph [0041]).

In conclusion, Buford et al teaches the same functionality as Appellant claimed subject matter as it parses e-mail message to obtain URL and e-mail address (See paragraph [0036]), and the features of the pairs are evaluated for consistency (See paragraph [0041]).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Djenane Bayard

/D. M. B./

Examiner, Art Unit 2441

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